

## REMARKS

The last Office Action has been carefully considered.

In the Office Action the Examiner rejected claims 1, 3 and 12 under 35 U.S.C. 103(a) over the patent to Lykes, et al in view of the patent to Takahashi, et al.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant retained claim 1 as it was, canceled claim 3, and submitted another independent claim 19.

Claim 1, the broadest claim on file, defines an electrical machine which has a stator received in a housing closed by a housing cap, and a rotor that includes a shaft which is rotatably received in roller bearings. The roller bearings are received by bearing rings which are supported in the stator, the stator is provided on its face ends with openings for receiving the bearing rings, the openings are configured as annular grooves extending in a circumferential direction, and the annular grooves are provided on an outer diameter of the stator.

Claim 19 exactly corresponds to claim 1, includes the same features, but provides a slightly different language, in particular it defines

that the annular grooves “that configure the openings (28, 29) for receiving the bearing rings (2) supported in the stator (1)” are provided on an outer diameter of the stator. All these features are defined in claim 1, but in a slightly different sequence. Therefore claim 19 does not raise any new issues for examination or search.

The Examiner indicated that the primary reference, namely the patent to Lykes, et al discloses the major part of the new features of the present invention, while the secondary reference, namely the patent to Takahashi, et al discloses the annular grooves shown in Figure 6, between winding and housing, that are provided on an outer diameter of the stator. In the Examiner’s opinion it would be obvious to combine the references and to arrive at the present invention from the combination of the references.

The patent to Takahashi in Figure 6 discloses an outer gap on the stator. However, in accordance with the present invention the annular grooves provided on an outer diameter of the stator form the openings 28, 29 for receiving the bearing rings 2, and the bearing rings 2 are supported in the stator 1.

In the patent to Takahashi including the showing in Figure 6, both bearings are always arranged inside the housing, in which the stator is inserted. This means that the bearing rings in the patent to Takahashi are simultaneously a part of the housing (100, 110, 120, 112, 114, 124).

The teaching of the patent to Takahashi exactly contradicts the features of claims 1 and 19, that the bearing rings are supported directly in the stator 5. In the patent to Takahashi a person skilled in the art would find no hint or suggestion, for which purpose the gap is formed between the stator and the housing. It is quite possible that this is done to mount the stator in the housing in a simpler way. A person of ordinary skill in the art who familiarize himself with the teaching of the patent to Takahashi, would not obtain any hint or suggestion to provide a support of a bearing ring directly in the stator since in Figure 6 of this reference it is an integral component of the housing.

It is therefore believed to be clear that the electrical machine in accordance with the present invention as defined in claims 1 and 19 is different from the motor disclosed in the patent to Takahashi in that the "bearing ring 2" is supported directly in the "annular groove" of the stator 1. The patent to Takahashi teaches away from the present invention and therefore its use as a reference can be equated only with an

unpermissible hindsight or post analysis, which can be derived only from the consideration of the present invention as defined in claims 1 and 9.

It is further emphasized that a person of ordinary skill in the art who familiarize himself with the patent to Lykes and the patent to Takahashi would not find any hint or suggestion for bearing rings arranged in annular grooves provided on an outer diameter of the stator, whether the references are taken singly or in combination with one another.

The present invention also provides for the highly advantageous results which can not be accomplished by the machines disclosed in the references. When the bearing rings are arranged in the annular grooves on an outer diameter of the stator, the rotor on the one hand can be directly adjusted relative to the stator. Simultaneously, when compared with the solution proposed in the patent to Lykes, the advantage is provided that by the mounting of the bearing rings the manufacturing tolerances of the air gap between the rotor and the stator are not influenced.

It is believed to be clear that the new features of the present invention as defined in claims 1 and 19 are not disclosed in the references, and the references do not contain any hint or suggestion for these features. In order to arrive at the applicant's invention from the

teachings of the references, the references have to be fundamentally modified by departing from their solutions and including into them the new features of the present invention which are now defined in claims 1 and 19. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the machines disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals in the case *Ex parte Tanaka, Marushma, and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to

accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 1 and 19 should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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